

REMARKS/ARGUMENTS

The foregoing amendments to the claims are of a formal nature, and do not add new matter. Claims 119-138 were pending in this application and were rejected on various grounds. Claim 134 is canceled without prejudice or disclaimer. Claim 132 have been amended to more clearly claim what the Applicant considers is the invention. The rejections to the presently pending claims are respectfully traversed.

Claim Rejections – 35 U.S.C. §112, First Paragraph - Enablement

Claims 119-123, 132 and 134 are rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. The Examiner asserts that the specification has only enabled the nucleic acids that encode the full-length polypeptide defined by SEQ ID NO: 345, and does not enable other variants. The Examiner notes that the claims are broad and hence, asserts that it would require undue experimentation to use the invention commensurate in scope with the claims.

The instantly pending claims have been amended to include a functional recitation "wherein the polypeptide encoded by said nucleic acid induces chondrocyte proliferation." Applicants once again request the Examiner to reconsider this rejection since the chondrocyte proliferation assay is a well established assay. One skilled in art would know how to make variants with 80- 99% identity to SEQ ID NO: 345 and the polypeptide of SEQ ID NO: 344 and to run these polypeptides through this assay. Since the instant claims only encompass polypeptides that possess the function of inducing chondrocyte proliferation, it is irrelevant at which positions these changes are made. Accordingly, Applicants submit that the skilled artisan would not require undue experimentation to make and use the claimed invention.

Accordingly, Applicants request that this rejection be withdrawn.

Claim Rejections - 35 U.S.C. §112, First Paragraph - Written Description

Claims 132 and 134 remain rejected under 35 U.S.C. §112, first paragraph, because, according to Examiner, the subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time of filing.

Without acquiescing to the propriety of this rejection, Applicants have canceled claim 134 and amended claim 132 to recite that the " isolated nucleic acid consisting of a fragment of the nucleic acid sequence of SEQ ID NO: 344 or a complement thereof that is at least 20

nucleotide in length, that specifically hybridizes under stringent conditions" to more clearly define the invention. One skilled in the art would know that the Applicants possessed the nucleic acids encompassed in these claims since the present invention pertains to the field of recombinant DNA/protein technology. It is well established that the level of skill in this field is very high since a representative person of skill is generally a Ph.D. scientist with several years of experience. Hence, Applicants submit that this rejection should be withdrawn.

Claim Rejections - 35 U.S.C. §102

Claims 132 and 134 remain rejected under 35 U.S.C. §102(b) as being anticipated by Ni *et al.* (U.S.P.N. 6566478) dated 2003.

Applicants submit that Ni does not anticipate claim 132 since it has only 51% identity to the instant nucleic acid and would only be able to hybridize under moderate conditions to Sequence ID NO: 344. Since the instant claims recite stringent conditions, the Ni sequence would not hybridize under these conditions. Accordingly, Ni *et al.* (U.S.P.N. 6566478) dated 2003 is not prior art and hence, this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641**, referencing Attorney's Docket No. **39780-2730 P1C61**).

Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: December 17, 2004

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